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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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EXAMINER

YOCKEY, DAVID F

ART UNIT	PAPER NUMBER
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2861

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DATE MAILED: 06/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/859,692

Applicant(s)

RHODES ET AL.

Examiner

David Yockey

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 March 2002 and 24 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31, 39-45 and 51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31, 39-45 and 51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Oath/Declaration

The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Claim Objections

Claims 2-5, 7-10, 13-15 and 51 are objected to because of the following informalities: "said cap" in claim 2 lacks antecedent basis. Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was

not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 27 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takanaka et al. (US 6,007,177) in view of Izumi et al. (JP404039055A).

Takanaka et al. discloses, in a first embodiment, a system comprising a service station (20) including a cap (101; Fig. 5) which covers a printhead (11) when positioned at the service station and a wiper (201; Fig. 9) which wipes the printhead during relative movement of the printhead and the wiper; and a source (401) of printhead servicing fluid. Takanaka et al. further discloses, in another embodiment, an applicator pump (1407 as shown in Fig 20, but also applicable to Fig. 21; see column 24, lines 45-58) having a fluid outlet (nozzle 1405; Fig. 21) for applying a predetermined quantity of the fluid to the printhead (see column 24, lines 42-43 regarding amount of rinsing liquid, i.e. predetermined quantity of the fluid).

Takanaka et al. lacks an applicator pump having a fluid outlet in the cap for applying a predetermined quantity of the fluid to the printhead.

Izumi et al. suggests, particularly in Fig. 2, providing a cleaning liquid jet nozzle (26) as a fluid outlet in the cap which applies a predetermined quantity of the cleaning liquid to a printhead (14) for eliminating clogging of ink nozzles ("jetting out continuously for a fixt [sic.] time or intermittently" clearly suggests jetting a predetermined in accordance with the time). It would have been obvious to one of ordinary skill in the art

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at the time the invention was made to combine a fluid outlet in the cap which applies a predetermined quantity of the cleaning liquid to the printhead in the Takanaka et al. apparatus because, as suggested by Izumi et al., such combination would facilitate elimination of clogging of ink nozzles.

While Izumi et al. is not seen to clearly disclose use of a pump to apply the fluid from the cleaning liquid jet nozzle to the printhead, Takanaka et al. discloses use of a pump to cause a predetermined quantity of cleaning liquid to be jetted from a nozzle onto a printhead, as discussed above. It would have been obvious to one of ordinary skill in the art at the time the invention was made to use a pump in combination with the modified first embodiment apparatus of Takanaka et al. to enable application of the predetermined quantity of fluid from the fluid outlet in the cap to the printhead in the combination.

With respect to claim 31, as the term "low volume" is broad, not being specifically defined relative to any particular volume, and the pump in the combination causes ink to be sprayed onto the printhead (as shown in Izumi et al. Fig. 2), the pump in the combination is interpreted to be a low volume spray pump.

Claim Rejections - 35 U.S.C. 251

Claims 1-5, 7-31 and 39-45 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

Claims 1-5, 7-15, 24, 27-31, 39, 43 and 51 are rejected under 35 U.S.C. 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present reissue is based. See *Hester Industries, Inc. v. Stein, Inc.*, 142 F.3d 1472, 46 USPQ2d 1641 (Fed. Cir. 1998); *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997); *Ball Corp. v. United States*, 729 F.2d 1429, 1436, 221 USPQ 289, 295 (Fed. Cir. 1984). A broadening aspect is present in the reissue which was not present in the application for patent. The record of the application for the patent shows that the broadening aspect (in the reissue) relates to subject matter that applicant previously surrendered during the prosecution of the application. Accordingly, the narrow scope of the claims in the patent was not an error within the meaning of 35 U.S.C. 251, and the broader scope surrendered in the application for the patent cannot be recaptured by the filing of the present reissue application.

Claims 27-31:

Presentation of the service station with neither a specific applicator and movable container, a specific wiper, nor an applicator at least partially formed of wicking material and located adjacent to a cap with fluid provided thereto by a pump provides the broadening aspect to the claims. At page 13, lines 3-4 of the amendment received 17 February 1998 (Paper #4) in the parent application, Applicants state with regard to claim 1 "The service system comprises two separate elements (for use with the printhead and wiper) comprising a source of servicing fluid including a fluid reservoir and a servicing fluid applicator. The applicator has a first portion in fluid communication with the

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reservoir, that portion being adapted to draw fluid from the reservoir and a second portion positioned for directly contacting at least one if two elements consisting of the printhead and the wiper. Unlike Burke discussed in greater detail below which uses the wiper to apply the cleaning fluid to the printhead, applicant uses a separate applicator which essentially acts as a one way gate in fluid communication with the reservoir so that the servicing fluid in the reservoir does not become contaminated by residue wiped by the wiper from the printhead", clearly indicating that presence of the specific applicator in the combination claimed was provided to distinguish over the prior art. Further, at page 14, lines 3-4 of the amendment received 17 February 1998 (Paper #4) in the parent application, Applicants state "New claims 21-29 relate to the embodiment exemplified in Figs. 2-4 which uses a movable (vertically) container...", clearly indicating the provision of a movable container as a feature upon which patentability was predicated so as to avoid rejection in view of the prior art. Additionally, at page 13, lines 15-17 of the same amendment, Applicants state with regard to claim 14 (corresponding to claim 18 in this application) "Burke does not show an arrangement with porous elastomeric foam situated between first and second impervious elastomeric layers of his wiper element", clearly indicating that the structure of the wiper in claim 14 was considered to distinguish from the prior art. Also, claim 9, defining subject matter directed to an applicator to which the pump pumps fluid which was indicated by the Examiner as allowable in the Office Action mailed 16 October 1998 (Paper #11), was amended to include the limitations of the base and intervening claims, clearly indicating that presence of the applicator in the combination claimed was retained to distinguish

over the prior art. Accordingly, Applicants have surrendered subject matter including a service station without at least one of a specific applicator and movable container, a specific wiper, nor an applicator at least partially formed of wicking material and located adjacent to a cap with fluid provided thereto by a pump.

Response to Amendment

The amendment filed 11 March 2002 is improper, as claim 27 should be underlined in their entirety. Matter to be added in a reissue must be underlined. See 37 CFR 1.173(b)(2) and 1.173(d).

Response to Arguments

Applicants arguments filed 11 March 2002 have been fully considered but they are not persuasive.

Applicants argue that the subject matter of claim 27 has not been surrendered because the subject matter is readable on Fig. 14 and that it is clear that other applicators can be used in the cap such as the types shown in Figs. 12 and 13. This argument is not persuasive. Whether or not the subject matter of a claim is readable on particular drawings is not germane to the issue. Applicants have surrendered the subject matter in the claim because the features upon which patentability was predicated have been removed from the subject matter of the claim. See *In re Clement*, 131 F.3d 1464, 45 USPQ2d 1161 (Fed. Cir. 1997).

Pertinent Prior Art

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Tajika et al. (JP403227647A) discloses a wiper having a composite wiper element having first and second impervious elastomeric layers (9), and a layer of porous elastomeric foam (7) sandwiched therebetween (see in particular Fig. 4).

Mori (JP406000964A) discloses liquid being supplied between layers of a composite wiper (Figs. 6 and 7).

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Yockey whose telephone number is (703) 308-3084. The examiner can normally be reached on weekdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Barlow can be reached on (703) 308-3126. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3431 for regular communications and (703) 305-3431 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.



**DAVID F. YOCKEY
PRIMARY EXAMINER**

DY
May 31, 2002